

REMARKS

Claims 6 and 10-26 remain herein. Claims 2 and 7-9 remain herein but are currently withdrawn from consideration.

1. Claims 6, 10-16 and 20 were rejected under 35 U.S.C. § 112, second paragraph. MPEP § 2173.05(s) permits incorporation by reference “where there is no practical way to define the invention in words and where it is more concise to incorporate by reference.” There is no practical way to define Applicants’ claimed invention in words without incorporating by reference in claims 6 and 20 the fitting data of FIG. 4. FIG. 4 discloses data for a Length of Control Club for a given combination of Player Height and Wrist-to-Floor Measurement data, representing 27 distinct combinations. This multiplicity of values makes it impractical to define the invention in words. Therefore, it is respectfully submitted that the rejection of claims 6, 10-16 and 20 under 35 U.S.C. § 112, second paragraph, should be withdrawn, and the data presented in FIG. 4 permitted to be incorporated by reference into claims 6 and 20, and be given weight as elements of those claims.

2. Claims 6 and 12 are rejected under 35 U.S.C. § 103(a) over Nakajima U.S. Patent 5,524,895 (“Nakajima”) in view of Llewellyn et al. U.S. Patent App. Publication 2004/0023725 A1 (“Llewellyn”) or Wohldorf U.S. Patent App. Publication 2005/0070369 A1 (“Wohldorf”).

The Office Action admits that Nakajima fails to teach a fitting system kit with data to fit a length of club to a player, and therefore does not teach the data presented in FIG. 4 of the

present invention. And, neither Llewellyn nor Wohldorf teaches the data of FIG. 4. Because the references alone and in combination fail to teach the data of Applicants' FIG. 4, as incorporated in claim 6, the references fail to teach every element of claim 6.

In addition to failing to teach each limitation included in claim 6, Nakajima, Llewellyn and/or Wohldorf are not properly combinable. There is no motivation or suggestion to combine the teachings of any these references. Nakajima discloses an actual golf club having a spherical club head. Llewellyn and Wohldorf disclose fitting systems using conventional clubs having traditional features, including lie angles and soles, and both Llewellyn and Wohldorf require using conventional fitting clubs to optimize aspects of the fitting. Llewellyn FIG. 1 shows a fitting club having "a sole 28 of the body 12 includ[ing] indicia 30 for identifying an optimal lie angle." ¶¶ [0018], [0029]. Wohldorf requires that the test club have a sole, as shown in FIGS. 4a-4c: "The test person carries out 1, 2 or more shots on the testing board with this test club. In the process, a marking appears on the sole 5 of the clubhead 1 which shows the point in which the sole 5 made contact with the testing board during the shot." ¶ [0046]. Because fitting data disclosed in both Llewellyn and Wohldorf are based on empirical results obtained with conventional clubs having traditional features and a specific progression within a set, they are incompatible with fitting tests taken with a club having a non-traditional spherical club head.

MPEP § 2143.01 states: "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." Modifying the conventional test clubs described in Llewellyn and Wohldorf by replacing the traditional club heads with spherical heads would

render the testing systems described in Llewellyn and Wohldorf unsatisfactory for their intended purposes.

For all the foregoing reasons, there is no disclosure or teaching in any of Nakajima, Llewellyn or Wohldorf of all elements of claim 6. Additionally, there is no motivation or suggestion to combine the teachings of Nakajima with the teachings of Llewellyn or Wohldorf. Claim 12 depends from claim 6 and patentably distinguishes over Nakajima in view of Llewellyn or Wohldorf for at least the same reasons. Accordingly, reconsideration and withdrawal of this ground of rejection are respectfully requested.

3. Claims 6 and 12 are rejected under 35 U.S.C. § 103(a) over Novosel U.S. Patent 5,026,064 ("Novosel") in view of Llewellyn or Wohldorf.

The Office Action admits that Novosel fails to teach a fitting system kit with data to fit a length of club to a player, and therefore does not teach the data of FIG. 4 of the present invention. And, neither Llewellyn nor Wohldorf teaches the data of FIG. 4. Because the references alone and in combination fail to teach the data of Applicants' FIG. 4, as incorporated in claim 6, the references fail to teach every element of claim 6.

In addition to failing to teach each limitation included in claim 6, Novosel, Llewellyn and/or Wohldorf are not properly combinable. There is no motivation or suggestion to combine the teachings of these references. Novosel discloses a golf club training device having a spherical club head. Llewellyn and Wohldorf each disclose fitting systems using conventional clubs having traditional features, including lie angles and soles, and both Llewellyn and

Wohldorf require using conventional fitting clubs to optimize aspects of the fitting. Llewellyn FIG. 1 shows a fitting club having “a sole 28 of the body 12 includ[ing] indicia 30 for identifying an optimal lie angle.” ¶¶ [0018], [0029]. Wohldorf requires that the test club have a sole, as shown in FIGS. 4a-4c: “The test person carries out 1, 2 or more shots on the testing board with this test club. In the process, a marking appears on the sole 5 of the clubhead 1 which shows the point in which the sole 5 made contact with the testing board during the shot.” ¶ [0046]. Because fitting data disclosed in both Llewellyn and Wohldorf are based on empirical results obtained with conventional clubs having traditional features and a specific progression within a set, they are incompatible with fitting tests taken with a club having a non-traditional spherical club head.

MPEP § 2143.01 states: “If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” Modifying the conventional test clubs described in Llewellyn and Wohldorf by replacing the traditional club heads with spherical heads would render the testing systems described in Llewellyn and Wohldorf unsatisfactory for their intended purposes.

For all the foregoing reasons, there is no disclosure or teaching in any of Novosel, Llewellyn or Wohldorf of all elements of applicants’ presently claimed invention. Additionally, there is no motivation or suggestion to combine the teachings of Novosel with the teachings of Llewellyn or Wohldorf. Claim 12 depends from claim 6 and patentably distinguishes over

Novosel in view of Llewellyn or Wohldorf for at least the same reasons. Accordingly, reconsideration and withdrawal of this ground of rejection are respectfully requested.

4. Claims 6 and 10-12 are rejected under 35 U.S.C. § 103(a) over Flood U.S. Patent 6,383,086 ("Flood") in view of Llewellyn or Wohldorf.

The Office Action admits that Flood fails to teach a fitting system kit with data to fit a length of club to a player, and therefore does not teach the data of FIG. 4 of the present invention. And, neither Llewellyn nor Wohldorf teaches the data of FIG. 4. Because the references alone and in combination fail to teach the data of Applicants' FIG. 4 as incorporated in claim 6, the references fail to teach every element of claim 6.

Furthermore, Flood and Llewellyn or Wohldorf are not properly combinable. There is no motivation or suggestion to combine the teachings of these references. Flood discloses a practice putter having a spherical club head. Llewellyn and Wohldorf each disclose fitting systems using conventional clubs having traditional features, including lie angles and soles, and both Llewellyn and Wohldorf require using conventional fitting clubs to optimize aspects of the fitting. Llewellyn FIG. 1 shows a fitting club having "a sole 28 of the body 12 includ[ing] indicia 30 for identifying an optimal lie angle." ¶¶ [0018], [0029]. Wohldorf requires that the test club have a sole, as shown in FIGS. 4a-4c: "The test person carries out 1, 2 or more shots on the testing board with this test club. In the process, a marking appears on the sole 5 of the clubhead 1 which shows the point in which the sole 5 made contact with the testing board during the shot." ¶ [0046]. Because fitting data disclosed in both Llewellyn and Wohldorf are based on empirical

results obtained with conventional clubs having traditional features and a specific progression within a set, they are incompatible with fitting tests taken with a club having a non-traditional spherical club head.

MPEP § 2143.01 states: "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." Modifying the conventional test clubs described in Llewellyn and Wohldorf by replacing the traditional club heads with spherical heads would render the testing systems described in Llewellyn and Wohldorf unsatisfactory for their intended purposes.

For all the foregoing reasons, there is no disclosure or teaching in any of Flood, Llewellyn or Wohldorf of all elements of applicants' presently claimed invention. Additionally, there is no motivation or suggestion to combine the teachings of Flood with the teachings of Llewellyn or Wohldorf. Claims 10-12 depend from claim 6 and patentably distinguish over Flood in view of Llewellyn or Wohldorf for at least the same reasons. Accordingly, reconsideration and withdrawal of this ground of rejection are respectfully requested.

5. Claims 6 and 12-13 are rejected under 35 U.S.C. § 103(a) over Yim U.S. Patent App. Pub. 2002/0061789 A1 ("Yim") in view of Llewellyn or Wohldorf.

The Office Action admits that Yim fails to teach a fitting system kit with data to fit a length of club to a player, and therefore does not teach the data presented in FIG. 4 of the present invention. And, neither Llewellyn nor Wohldorf teaches the data of FIG. 4. Because the

references alone or in combination fail to teach the data of Applicants' FIG. 4 as incorporated in claim 6, the references fail to teach every element of claim 6.

Further, Yim and Llewellyn or Wohldorf are not properly combinable. There is no motivation or suggestion to combine the teachings of these references. Yim discloses a putting stroke trainer having a spherical club head. Llewellyn and Wohldorf each disclose fitting systems using conventional clubs having traditional features, including lie angles and soles, and both Llewellyn and Wohldorf require using conventional fitting clubs to optimize aspects of the fitting. Llewellyn includes in FIG. 1 a fitting club having "a sole 28 of the body 12 includ[ing] indicia 30 for identifying an optimal lie angle." ¶¶ [0018], [0029]. Wohldorf requires that the test club have a sole, as shown in FIGS. 4a-4c: "The test person carries out 1, 2 or more shots on the testing board with this test club. In the process, a marking appears on the sole 5 of the clubhead 1 which shows the point in which the sole 5 made contact with the testing board during the shot." ¶ [0046]. Because fitting data disclosed in both Llewellyn and Wohldorf are based on empirical results obtained with conventional clubs having traditional features and a specific progression within a set, they are incompatible with fitting tests taken with a club having a non-traditional spherical club head.

MPEP § 2143.01 states: "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." Modifying the conventional test clubs described in Llewellyn and Wohldorf by replacing the traditional club heads with spherical heads would

render the testing systems described in Llewellyn and Wohldorf unsatisfactory for their intended purposes.

For all the foregoing reasons, there is no disclosure or teaching in any of Yim, Llewellyn or Wohldorf of all elements of applicants' presently claimed invention. Additionally, there is no motivation or suggestion to combine the teachings of Yim with the teachings of Llewellyn or Wohldorf. Claims 12 and 13 depend from claim 6 and patentably distinguish over Yim in view of Llewellyn or Wohldorf for at least the same reasons. Accordingly, reconsideration and withdrawal of this ground of rejection are respectfully requested.

6. Claims 6, 14 and 16 are rejected under 35 U.S.C. § 103(a) over Witherspoon U.S. Patent 3,759,527 ("Witherspoon") in view of Llewellyn or Wohldorf.

The Office Action admits that Witherspoon fails to teach a fitting system kit with data to fit a length of club to a player, and therefore does not teach the data presented in FIG. 4 of the present invention. And, neither Llewellyn nor Wohldorf teaches the data of FIG. 4. Because the references alone or in combination fail to teach the data of Applicants' FIG. 4 as incorporated in claim 6, the references fail to teach every element of claim 6.

Further, Witherspoon, Llewellyn or Wohldorf are not properly combinable. There is no motivation or suggestion to combine the teachings of these references. Witherspoon discloses a golf club having a spherical club head. Llewellyn and Wohldorf each disclose fitting systems using conventional clubs having traditional features, including lie angles and soles, and both Llewellyn and Wohldorf require using conventional fitting clubs to optimize aspects of the

fitting. Llewellyn includes in FIG. 1 a fitting club having “a sole 28 of the body 12 includ[ing] indicia 30 for identifying an optimal lie angle.” ¶¶ [0018], [0029]. Wohldorf requires that the test club have a sole, as shown in FIGS. 4a-4c: “The test person carries out 1, 2 or more shots on the testing board with this test club. In the process, a marking appears on the sole 5 of the clubhead 1 which shows the point in which the sole 5 made contact with the testing board during the shot.” ¶ [0046]. Because fitting data disclosed in both Llewellyn and Wohldorf are based on empirical results obtained with conventional clubs having traditional features and a specific progression within a set, they are incompatible with fitting tests taken with a club having a non-traditional spherical club head.

MPEP § 2143.01 states: “If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” Modifying the conventional test clubs described in Llewellyn and Wohldorf by replacing the traditional club heads with spherical heads would render the testing systems described in Llewellyn and Wohldorf unsatisfactory for their intended purposes.

For all the foregoing reasons, there is no disclosure or teaching in any of Witherspoon, Llewellyn or Wohldorf of all elements of applicants’ presently claimed invention. Additionally, there is no motivation or suggestion to combine the teachings of Witherspoon with the teachings of Llewellyn or Wohldorf. Claims 14 and 16 depend from claim 6 and patentably distinguish over Witherspoon in view of Llewellyn or Wohldorf for at least the same reasons. Accordingly, reconsideration and withdrawal of this ground of rejection are respectfully requested.

7. Claims 14-15 are rejected under 35 U.S.C. § 103(a) over Yim in view of Llewellyn or Wohldorf as applied to claims 6 and 12-13, and further in view of Witherspoon.

As described above, neither Yim in view of Llewellyn or Wohldorf nor Witherspoon in view of Llewellyn or Wohldorf teaches every element of independent claim 6. Likewise, as Applicants have explained above herein, there is no motivation or suggestion to combine the teachings of either Yim or Witherspoon with the teachings of Llewellyn or Wohldorf. Claims 14 and 15 depend from claim 6 and patentably distinguish over Yim or Witherspoon in view of Llewellyn or Wohldorf for at least the reasons described above. Accordingly, reconsideration and withdrawal of this ground of rejection are respectfully requested.

8. Claims 17, 20 and 25 are rejected under 35 U.S.C. § 103(a) over Novosel in view of Llewellyn.

As described above, there is no proper motivation or suggestion to combine the teachings of Novosel and Llewellyn. Modifying the conventional test clubs described in Llewellyn by replacing the traditional club heads with the spherical heads disclosed in Novosel would render the testing systems described in Llewellyn unsatisfactory for their intended purposes, in violation of MPEP § 2143.01. Accordingly, reconsideration and withdrawal of this ground of rejection are respectfully requested.

9. Claims 17-20 and 25 are rejected under 35 U.S.C. § 103(a) over Flood in view of Llewellyn.

As described above, there is no proper motivation or suggestion to combine the teachings of Flood and Llewellyn. Modifying the conventional test clubs described in Llewellyn by replacing the traditional club heads with the spherical heads disclosed in Flood would render the testing systems described in Llewellyn unsatisfactory for their intended purposes, in violation of MPEP § 2143.01. Accordingly, reconsideration and withdrawal of this ground of rejection are respectfully requested.

10. Claims 17, 20, 21 and 25-26 are rejected under 35 U.S.C. § 103(a) over Yim in view of Llewellyn.

As described above, there is no proper motivation or suggestion to combine the teachings of Yim and Llewellyn. Modifying the conventional test clubs described in Llewellyn by replacing the traditional club heads with the spherical heads disclosed in Yim would render the testing systems described in Llewellyn unsatisfactory for their intended purposes, in violation of MPEP § 2143.01. Accordingly, reconsideration and withdrawal of this ground of rejection are respectfully requested.

11. Claims 17, 20, 22-23 and 25 are rejected under 35 U.S.C. § 103(a) over Witherspoon in view of Llewellyn.

As described above, there is no proper motivation or suggestion to combine the teachings of Witherspoon and Llewellyn. Modifying the conventional test clubs described in Llewellyn by replacing the traditional club heads with the spherical heads disclosed in Witherspoon would render the testing systems described in Llewellyn unsatisfactory for their intended purposes, in violation of MPEP § 2143.01. Accordingly, reconsideration and withdrawal of this ground of rejection are respectfully requested.

12. Claims 22-24 are rejected under 35 U.S.C. § 103(a) over Yim in view of Llewellyn as applied to claims 17, 20, 21, and 25-26, and further in view of Witherspoon.

As described above, there is no motivation or suggestion to combine the teachings of either Yim or Witherspoon with the teachings of Llewellyn because it violates MPEP § 2143.01. Accordingly, reconsideration and withdrawal of this ground of rejection are respectfully requested.

For all the foregoing reasons, all claims 6 and 10-26 are patentably distinguished over all grounds of rejection cited in the Office Action and are otherwise in condition for allowance. Accordingly, withdrawal of all rejections and allowance of all claims 6 and 10-26 are respectfully requested.

Should the Examiner deem that any further action by the applicants would be desirable for placing this application in even better condition for issue, the Examiner is requested to telephone applicants' undersigned representative at the number listed below.

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Respectfully submitted,

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